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PATENT TRADEMARK OFFICE

Patent
Case No. 56719US002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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04/16/03

First Named Inventor: **CHHEANG, THEARY**

Application No.: **09/896,655** Group Art Unit: **1714**

Filed: **June 29, 2001** Examiner: **Katarzyna I. Wyrozebski Lee**

Title: **DEVICES, COMPOSITIONS, AND METHODS INCORPORATING ADHESIVES WHOSE PERFORMANCE IS ENHANCED BY ORGANOPHILIC CLAY CONSTITUENTS**

INTERVIEW SUMMARY and RESPONSE to RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, DC 20231

CERTIFICATE OF TRANSMISSION

To Fax No.: 703-872-9310
I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office on:

April 14, 2003 (Date) Carol Decaire (Carol Decaire)

Dear Sir:

This response is to the Office Action mailed March 18, 2003.

Interview Summary

Applicants and their representative thank Examiner Katarzyna I. Wyrozebski Lee for telephoning on March 14, 2003 to described the restriction requirement. Applicants' representative requested written restriction due to multiple groupings.

Restriction

Claims 1-35 have been restricted under 35 U.S.C. § 121 as follows:

I. Claims 1-11 are said to be drawn to hot melt adhesive comprising exfoliated clay, classified in class 524, subclass 445;

II. Claims 12-24 are said to be drawn to conductive adhesive comprising exfoliated clay and conductive particle, classified in class 427, subclass 117;

III. Claim 25 is said to be drawn to method for providing electrical connection, classified in class 252, subclass 500;

IV. Claims 26-30, 33 are said to be drawn to method of making electroconductive adhesive, classified in class 425, subclass 113;

V. Claims 31-32 are said to be drawn to making of electronic assembly, classified in class 414, subclass 904; and

VI. Claim 34 is said to be drawn to electroconductive adhesive tape, classified in class 428, subclass 343.

Applicants respectfully request reconsideration and withdrawal or modification of the restriction requirement.

First, claim 35 was listed in the Office Action Summary, however, it was not included in any of the claim groups. Applicants believe claim 35 should be examined with Group II, and alternatively request review and correction of the Restriction Requirement.

Second, it is believed that the concept claimed in claim 12 (Group II), for example, links Group II to Groups I, III, IV, and V. The inventions of all Groups are related as adhesives that comprise organophilic clay, further adhesive ingredients, and uses of these adhesives.

In addition, Applicants note that the composition of claim 12 (Group II) must be included in the method of claims 25, 26, 31, and 35 (Groups III, IV, V, and II?). When claim 12 is found patentable, these other claims also should be found patentable. These inventions of Groups I-V are closely related in the field of adhesives having organophilic clay that a proper search of any of the claims would, by necessity, require a proper search of the others. Thus, Applicants submit that all of the claims can and should be searched simultaneously, and that a duplicative search, with possibly inconsistent results, may occur if the restriction requirement is maintained.

Applicants submit that any nominal burden placed upon the Examiner to search for all Groups accordingly to determine the art relevant to Applicants' overall invention is significantly outweighed by the public's interest in not having to obtain and study many separate patents in order to have available all of the issued patent claims covering Applicants' invention. The alternative is to proceed with the filing of multiple applications, each consisting of generally the same disclosure, and each being subjected to essentially the same search, perhaps by different Examiners on different occasions. This process would place an unnecessary burden on both the Patent and Trademark Office and on the Applicants.

Applicants respectfully note that, even if the inventions are independent or distinct, the Examiner need not have restricted the application, and therefore need not maintain the restriction. MPEP § 803 requires that "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." Thus, it is not mandatory to make a restriction requirement in every situation.

In the interest of economy for the Examiner, the PTO, the public, and the Applicants, reconsideration and withdrawal of the restriction requirement are requested.

Nevertheless, to comply with the requirements of 37 C.F.R. § 1.143, Applicants provisionally elect, with traverse, to prosecute the invention of Group II, namely claims 12-24 (and 35).

Respectfully submitted,

April 14, 2003
Date

By: _____
Dean M. Harts, Reg. No. 47,634
Telephone No.: 651-737-2325

Office of Intellectual Property Counsel
3M Innovative Properties Company

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56719US002 RESPONSE TO RR

FACSIMILE TRANSMITTAL COVER SHEET

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To: Examiner Katarzyna I. Wyrozebski Lee
U.S. Patent & Trademark Office
Washington, DC 20231

Phone: (703) 306-5875
Fax: (703) 872-9310

From: Dean M. Harts
Office of Intellectual Property Counsel
3M Innovative Properties Company
P.O. Box 33427
St. Paul, MN 55133-3427
Phone: (651) 737-2325
Fax: (651) 575-1293

Message:

Re: Interview Summary and Response to Restriction Requirement
Inventors: Theary Chheang
Application No.: 09/896,655
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